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REMARKS

Claims 1-44 were rejected as being anticipated under 35 USC §102(b) by Kirsch, US patent 5,870,546A. Reconsideration and withdrawal of these rejections are respectfully requested, for the following reasons.

I. Claim 1 and its dependent claims

The inventions of claim 1 is

"a method for a first server to select content to be displayed on a computer accessing a Web site of a second server".

In contrast, Kirsch, discloses methods for redirecting hyper-links to external servers. These are not the same operations. In Kirsch, the server 16, in response to an HTTP request from the client 12, serves up a web page to the client 12. the web page includes an embedded URL to a web page served by an external server (such as server 18 in Fig. 2). When and if the client 12 selects this embedded URL "results in an HTTP transaction with the server system 16 rather than the external server". Responsive to this HTTP transaction, the server system 16 provides a redirection response in the form of a redirection URL (having the following syntax **http://<direct_server>/redirect?<data>?http://<redirect_server>**) to the client system 12, which provides the client system with the corresponding redirection URL. See Col. 6, lines 51-64. The remainder of Kirsch simply fleshes out this concept. Kirsch's method allows for the server 16 to be kept in the loop when external server accesses are requested by the client 12, thereby allowing an accurate accounting and auditing of external server accesses by the client 12 from a server 16 – provided web page.

Independent claim 1, on the other hand, recites steps of:

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collecting user identification data from the computer accessing the Web site;
sending the collected user identification data to the first server;
retrieving user information corresponding to the user identification data from a database of user information accessible to the first server;
applying the retrieved user information to a rule base including a plurality of rules;
selecting content to be displayed on the second server's Web site based upon a result of the application of the retrieved user information to at least one of the plurality of rules, and
causing the Web site to display the selected content to the accessing computer.

The Office Action points to Col. 5, lines 25-45 for the proposition that Kirsch discloses "user [sic, data] specific to the user is obtained from a user's client machine." However, Col. 5, lines 25-45 says nothing about user data being obtained from a user's client machine.

The Office also points to Fig. 2 and Col. 7, lines 8-12 as teaching storage of such data in a database that is external to the server. It is to be noted that the claims do not require the database to be external to the server, as alleged in the Office Action.

More importantly, however, is that the Office points to Kirsch for a teaching of "the claimed actions of viewing contents of a second website from a second server when the client accesses only the first server is contained in Kirsch's design" and again cited the aforementioned Col. 5, lines 25-45. At the outset, none of the pending claims recite such alleged "claimed actions".

Indeed, the pending claims do not recite any steps of "viewing contents of a second website when the client accesses only the first server". Therefore, even if Kirsch were to teach such steps and/or functionality (which it does not), it is respectfully submitted that such teaching would have no bearing upon the patentability of the pending independent claims of the present application. Independent claim 1, for example, recites steps of collecting user identification data

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from the computer accessing the Web site and sending the collected information to the first server. Thereafter, the first server is recited to retrieve user information corresponding to the user identification data from a database of user information. Rules are then applied to this user information and content is selected. The Web site accessed by the user is then caused to display the selected content. There is no "second website from a second server" recited in any of the independent claims. Note that only one website is recited in independent claim 1 and the other independent claims. The recited website is that of the second server, and the first server, as claimed, is configured to select content to be displayed on the recited website of the second server, based upon collected user information, and the application of rules to the collected user information. The website of the second server is then caused to display the content selected by the first server, as claimed.

In Kirsch, the client 12 is viewing the website of the server 16, and selects a hyper-link of an advertiser, which sets Kirsch's method into action, which ultimately leads the client 12 to display a second website (whose address is the redirected URL). In the claimed embodiments, however, the user is views a website of a second server (see preamble), and the first server causes the same website of the same second server to display content that has been selected on the basis of collected user information and one or more of the plurality of rules in the rule base. Such is not taught or suggested in the Kirsch reference. Indeed, the Kirsch reference does not cause "the Web site to display the selected content to the accessing computer"¹, as claimed. Instead, Kirsch causes the accessing computer to access another server or website located at the redirection address. It is, therefore, respectfully submitted that the pending claims are not anticipated by Kirsch. It is respectfully requested, therefore, that the 35 USC §102(b) rejection

¹ Emphasis on the definite article "the" added – the Web site referenced by the definite article is the same Web site as introduced in the preamble.

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of the pending claims be reconsidered and withdrawn. It is not believed to be necessary to discuss the rejections of dependent claims 2-17, as they, by definition, include all of the limitations of the independent claims from which they depend.

II. Claim 18 and its dependent claims

Claim 18, as amended herewith, recites:

A system comprising:

a merchant Web server;

an affiliate Web server, the affiliate Web server being coupled to the merchant Web server over a computer network;

a database of user information accessible to the merchant Web server;

a rule base including a plurality of configurable rules, the rule base being accessible to the merchant Web server;

a first process to collect a user identification from a computer accessing a Web site controlled by the affiliate Web server and for sending the collected user identification to the merchant Web server along with a request for content;

a second process for retrieving user information from the database corresponding to the collected user identification, and identification;

a third process for applying user information obtained from the database to the plurality of rules and for returning selected content to the affiliate Web server in response to the request for content, the returned content being selected based upon a result of applying the user information to the plurality of rules, and

a fourth process to integrate the selected content into the Web site controlled by the affiliate server.

In rejecting claim 18, the Office used exactly the same language as it did in rejecting claim 1. The Remarks above regarding these grounds for rejection, therefore, are incorporated herein as if repeated in full. In this case, the user identification is collected from the computer accessing the Web site controlled by the affiliate Web server. The collected user identification is sent to the merchant server along with a request for content. The merchant Web server, thereafter, retrieves user information from a database corresponding to the collected user

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identification. This user information is then applied to a plurality of rules and content is selected on the basis thereof, the selected content being sent back to the affiliate server in response to the request for content by the affiliate. These steps, for the reasons developed above, are also not shown or suggested in the Kirsch reference. Indeed, for the purposes of claim 18, the phrase "affiliate Web server" may be substituted for "second server" and the phrase "merchant Web server" may be substituted for "first server". It should be noted in this regard that Kirsch, as developed fully above, causes the client 12 to access another server or web site whose address is the redirection URL provided by the server 16. The embodiment of amended claim 18, on the other hand, specifies that the content selected by the merchant server is integrated into the Web site controlled by the affiliate web server. The entire basis of Kirsch, it should also be noted, is the client selecting a URL of an external server, and the server 16 mediating access to the external server or Web site through redirection URLs. Kirsch's methods, therefore, do not teach or suggest the claimed subject matter in which the Web site controlled by the Affiliate is the only site that is recited. The amendments to claim 18 emphasize this point — Kirsch does not teach any step or method to integrate content selected in the claimed manner into a Web site. In view of the foregoing remarks and those developed relative to independent claim 1, therefore, it is respectfully submitted that the 35 USC §102(b) rejections applied to claim 18 and its dependent claims should be reconsidered and withdrawn. The same is, therefore, respectfully requested.

III. Claim 35 and its dependent claims

Claim 35 recites:

(Original) A method of delivering personalized content from a first server to a computer accessing a second server, comprising the steps of:

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receiving a request for the personalized content from the accessing computer, the accessing computer having accessed a Web page that includes embedded code configured to send the request for personalized content to the first server over a computer network along with selected user identification data;

retrieving user information corresponding to at least one of the user identification data and the accessed Web page from a database of user information accessible to the first server;

applying the retrieved user information to a rule base including a plurality of rules;

selecting content to be posted in the accessed Web page based upon a result of the application of the retrieved user information to at least one of the plurality of rules, and

sending at least one of the selected content and an address of the selected content to the accessing computer for posting into the accessed Web page.

In rejecting this claim, the Office merely repeated the same bases for rejection advanced relative to the rejections of claims 1 and 18. The arguments above regarding these grounds for rejection, therefore, are incorporated herein as if repeated in full.

At the outset, it should be noted that Kirsch does not teach or suggest a step of receiving a request for personalized content, as required by claim 35. Kirsch, as noted above, teaches that the client 12 accesses another external server web site whose address is the redirection URL provided by the server 16. The end result of Kirsch is that the client 12 gets redirected to an external server after having selected a hyper-link pointing to the external server. Kirsch's server 16 wedges itself in that transaction to maintain accurate tracking and auditing numbers. Nowhere does Kirsch teach a request for personalized content, and much less a request for personalized content that is accompanied by selected user identification data, as claimed. The Office has not pointed to any teaching in Kirsch that evidences such a step.

The embodiment of amended claim 35 specifies that the content selected by the first server is posted into the accessed Web page controlled by the second server. Kindly recall that

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the entire basis of Kirsch is the client selecting a URL of an external server, and the server 16 mediating the access to the external Web site through redirection URLs. Kirsch's methods, therefore, do not teach or suggest the claimed subject matter in which the Web page controlled by the second server is the only site that is recited. Kirsch does not teach any step or method to post content selected in the claimed manner into the accessed Web page. The end result in Kirsch is that the client 12 is redirected to an external server, not that some form of personalized content is posted in the currently accessed Web page, as specifically claimed in claim 35. In view of the foregoing remarks, it is respectfully submitted that the 35 USC §102(b) rejections applied to claim 35 and its dependent claims should be reconsidered and withdrawn.

Applicant's attorney, therefore, respectfully submits that all claims are allowable and that the present application in condition for an early allowance and passage to issue. If any unresolved issues remain, please contact the undersigned attorney of record at the telephone number indicated below.

Respectfully submitted,

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